fer of copyright ownership if the license is evidenced by a written instrument signed by the owner of the rights licensed or such owner's duly authorized agent, and if—(1) the license was taken before execution of the transfer; or (2) the license was taken in good faith before recordation of the transfer and without notice of it."

COUNTERSTATEMENT OF THE CASE

According to the allegations of her complaint, Petitioner Nancey Silvers wrote the script for a made-for-television movie called "The Other Woman" as a work made for hire for a company called Frank & Bob Films II ("Frank & Bob"). (App 63.)[1] Frank & Bob was thus the "author" of the script and was vested with the copyright in the script at the outset. (App.2; 17 U.S.C. § 201(b).)

About three years after the "The Other Woman" aired on television, Respondent Sony Pictures Entertainment Inc. ("Sony") released the motion picture "Stepmom." (Pet. at 3.) Sometime after the release of "Stepmom," Frank & Bob assigned to Silvers "all . . . claims . . . against Sony Pictures . . . and any other appropriate persons or entities, with respect to the screenplay 'The Other Woman' . . . and the motion picture 'Stepmom.'" (*Id.*) Frank & Bob made only this assignment of claims and did not assign any interest in the copyright in "The Other Woman" to Silvers. (App.71.)

Silvers then filed a copyright infringement suit against Sony, claiming that "Stepmom" was substantially similar to the script for "The Other Woman" (*Id.*) Frank & Bob

[1] References to the Petition's Appendix appear as "App.__", references to the addendum to this Brief appear as "Opp.Add.__."

was not a party to the suit and the district court read the assignment as prohibiting Silvers from joining Frank & Bob.[2] (Opp Add.3 (Order Granting Defendants' Motion for Interlocutory Appeal, Mar. 29, 2001))

Silvers's sole asserted basis for standing was the Assignment of Claims from Frank & Bob. Sony, relying principally on 17 U.S.C. § 501(b) ("The legal or beneficial owner of an exclusive right under a copyright is entitled to institute an action for any infringement . "), moved to dismiss the complaint on the ground that Silvers lacked standing to bring a copyright infringement action because she did not own any rights in the copyright and instead was only the assignee of a bare claim (App.71) The district court denied Sony's motion and certified its ruling for interlocutory appeal pursuant to 28 U.S.C § 1292(b). (Pet. at 4, App.71, Opp Add.1-4.) A panel of the Court of Appeals for the Ninth Circuit affirmed *See Silvers v. Sony Pictures Entm't Inc.*, 330 F.3d 1204 (9th Cir 2003). The Court of Appeals then voted to hear the case en banc, 370 F 3d 1252 (9th Cir. 2004), and reversed the district court, 402 F 3d 881 (9th Cir. 2005) (App 18, 79) A majority of the Court of Appeals first observed that § 501(b) of the Copyright Act of 1976 (the "1976 Act" or the "Act") confers standing to sue for copyright infringement only on the "legal or beneficial owner of an exclusive right under a copyright." The majority then looked to the statute, its legislative history, copyright case law from other circuits, and analogous patent law, and interpreted § 501(b) to mean

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[2] The district judge apparently read the strong indemnity and "no publicity" provisions in the Assignment as inconsistent with Frank & Bob's involuntary joinder. (*See* Opp Add 6 (Assignment of Claims and Causes of Action))

exactly what it says, and held that Silvers, who never has owned any interest in the underlying copyright, lacked standing to sue. (App. 18.)

LEGAL DISCUSSION

THIS COURT SHOULD DENY SILVERS'S PETITION BECAUSE IT FAILS TO SATISFY THE REQUIREMENTS FOR CERTIORARI REVIEW

Silvers's petition for writ of certiorari from the en banc decision of the Ninth Circuit Court of Appeals (the "Decision") satisfies none of the criteria for review in this Court. No decision interpreting the 1976 Act and its standing provisions supports Silvers's position. There is no assertion that the Decision conflicts with any relevant decision of this Court. Nor does this case involve any unresolved question of federal law requiring intervention by this Court Silvers, moreover, does not argue that the standing rule adopted by the Decision would in any way interfere with the ability of copyright owners to enjoy or enforce their rights.

Silvers's argument that the Decision conflicts with a 1969 decision by the Fifth Circuit Court of Appeals is simply wrong. That Fifth Circuit decision involved a different (now repealed) copyright statute (the "1909 Act"), with entirely different notions of copyright ownership and standing to sue, and thus is not in conflict with, and indeed could not conflict with, a decision construing current provisions that appeared for the first time in the 1976 Act Decisions in the Second Circuit, moreover, addressing the issue of standing under the 1976 Act are in accord with the Decision here. The petition thus involves no more than a

request to overturn settled principles of copyright jurisprudence that are firmly rooted in the 1976 Act

A. There Is No Conflict Among The Circuits On The Issue Of Standing To Sue For Copyright Infringement

Silvers alleges a conflict between the Decision and one other decision: *Prather v. Neva Paperbacks, Inc.*, 410 F.2d 698 (5th Cir. 1969), a case interpreting the standing provision of the predecessor 1909 Act. Under the 1909 Act, a copyright was considered "indivisible" and the single "proprietor" of the copyright was given standing to sue for infringement. 17 U.S.C. § 101(b) (1976) (repealed), *Gardner v. Nike, Inc.*, 279 F.3d 774, 778 (9th Cir. 2002). In *Prather*, the copyright plaintiff obtained an assignment of a copyright together with accrued infringement claims, and transferred certain rights back to the prior owner. 410 F.2d at 699 & n.3. The defendant argued that the plaintiff had not become the "proprietor" because he did not own the entire copyright and therefore he lacked standing to sue. *Id.* at 699. The *Prather* court held that the plaintiff did have standing because he held a valid assignment of the claim. *Id.* at 700.

Prather is inapposite for two reasons, as explained in the Decision. (*See* App. 15.) First, it was decided under the 1909 Act and is therefore of no assistance in interpreting 17 U.S.C. § 501(b), which had no analogue in the 1909 Act. The provision in § 501(b) authorizing suits by owners of exclusive rights, and no one else, did not exist in the 1909 Act.

Second, the plaintiff in *Prather* received the transfer of an ownership interest in the underlying copyright contem-

poraneously with the assignment of the accrued causes of action, meaning that the most crucial fact of the instant case—that Silvers was assigned a naked cause of action with no accompanying interest in the copyright—was not present in *Prather*. As the Decision states, "the *Prather* court was not faced, as we are, with a situation in which the owner of all the exclusive rights and the owner of the accrued causes of action are two different people." (App.15.)

The only circuit other than the Ninth to have addressed the issue of standing raised here is the Second, and, as the Decision itself notes (App.15-17), the Decision fully accords with the Second Circuit's decisions. For example, in *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27 (2d Cir 1982), the court stated: "We do not believe that the [1976] Copyright Act permits holders of rights under copyrights to choose third parties to bring suits on their behalf. While F. R. Civ. P. 17(a) ordinarily permits the real party in interest to ratify a suit brought by another party, the Copyright Law [in § 501(b)] is quite specific in stating that only the 'owner of an exclusive right under a copyright' may bring suit." *Id.* at 32 n.3 (citations omitted). In *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 944 F.2d 971 (2d Cir. 1991), the court again found that "the Copyright Act does not permit copyright holders to choose third parties to bring suits on their behalf." *Id.* at 980 [3]

[3] Judge Bea's dissent below takes issue with the majority's reading of both Second Circuit cases. Judge Bea argues that *Eden Toys* is distinguishable and barred only the assignment of future claims for infringement, not accrued causes of action. (App. 58-59.) The language quoted in text above, however, remains part of the Second Circuit's analysis and shows that that court is in accord with the Decision below.

(footnote continued on the following page)

The alleged "Circuit conflict" created by the Decision is therefore entirely illusory. Every decision addressing the standing provision in the 1976 Act is consistent with the Decision.[4]

While the *ABKCO* court did note, as Judge Bea points out, that the assignee's "right to bring the claims ar[ose] not out of its ownership of the copyright, but from its ownership of the claims themselves" (App.60-61 (citing *ABKCO*, 944 F.2d at 980-81)), the Second Circuit was merely reaffirming the general rule that the transfer of an ownership interest in a copyright does not carry with it an assignment of accrued causes of action unless those causes of action are *specifically* assigned to the transferee. *E.g.*, *ABKCO*, 944 F.2d at 980; *R&R Recreation Prods., Inc. v. Joan Cook Inc.*, No. 91-Civ.-2589 (JSM), 1992 WL 88171, at *4 (S.D.N.Y. Apr. 14, 1992); *Skor-Mor Products, Inc. v. Sears, Roebuck & Co.*, No. 81-Civ.-1286-CSH, 1982 WL 1264, at *3 (S.D.N.Y. May 12, 1982); MELVILLE B. NIMMER & DAVID NIMMER, 3 NIMMER ON COPYRIGHT, § 12.02[B], at 12-57 to -58 & n.26 (2005) (hereinafter "NIMMER"). In all events, the assignee in *ABKCO* held both the copyright as well as the accrued cause of action. *ABKCO*, 944 F.2d at 980-81.

[4] *See also, e.g.*, *Zenix Industrial U.S.I., Inc. v. King Hwa Industrial Co.*, Nos. 88-5760, 89-55729, and 88-5936, 1990 WL 200234, at *2 (9th Cir. Dec. 7, 1990) ("Section 501 of the [1976] Copyright Act gives the power to claim infringement only to copyright owners or exclusive licensees."); *Motta v. Samuel Weiser, Inc.*, 768 F.2d 481, 483-84 (1st Cir. 1985) ("If a plaintiff is not the author of the copyrighted work then he or she must establish a proprietary right through the chain of title in order to support a valid claim to the copyright. Absent this showing, a plaintiff does not have standing to bring an action under the [1976] Copyright Act."); *R. Ready Productions, Inc. v. Cantrell*, 85 F. Supp. 2d 672, 684 n.11 (S.D. Tex. 2000) (parties without an "ownership interest in the copyright" lack standing to sue under the 1976 Act pursuant to § 501); *Broadcast Music, Inc. v. CBS Inc.*, No. 83-Civ.-5004-CSH, 1983 WL 1136, at *6 (S.D.N.Y. July 20, 1983) (even if plaintiff could show it was vested with the exclusive right of enforcement as to copyrights belonging to a third party, this would not provide it with standing under the 1976 Act, which is given only to "'the legal or beneficial owner of an exclusive right *under a copyright*'" pursuant to § 501(b)) (citations omitted).

B. The Decision Is Correct And Creates No Uncertainties Or Anomalies Meriting The Attention Of This Court

1. Applicable Copyright Law Principles Show That The Decision Is Correct And In Accord With The Relevant Provisions Of The 1976 Act

As we show below, the 1976 Act goes so far as to provide standing to owners of exclusive rights in copyright, and no further. For more than 170 years, copyright law has been well-settled that "the protection given to copyrights is wholly statutory," *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984) (citing *Wheaton v. Peters*, 33. U.S (8 Peters) 591 (1834)), and the courts are not authorized to expand o hat Congress has done.

Under the 1909 Act, a copyright was "indivisible," meaning that only one person or entity could own a copyright, and only this "proprietor" of the copyright was given standing to sue for infringement. 17 U S C § 101(b) (1976) (repealed), *Gardner v. Nike*, 279 F 3d 774, 777-78 (9th Cir. 2002). The 1976 Act, which was the product of almost two decades of drafting, deliberation and compromise, abolished the notion of copyright "indivisibility," and for the first time in American copyright jurisprudence, provided that specified aspects of copyright ownership could be separately conveyed, owned, and enforced by others, *i.e.*, that copyright ownership could be divided, and that the "owners" of the specified rights all were authorized to sue in their own names for infringement of the rights they own. Thus, § 201(d) of the Act expressly provides that "ownership of a copyright may be transferred in whole or in part," and that

> [a]ny of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by [the previous] clause [ ] and owned separately.

17 U.S.C. § 201(d)(1), (2). This section further provides that "The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title." 17 U.S.C. § 201(d)(2).

The "exclusive rights" in a copyright are specifically defined in § 106 of the Act and are expressly referred to in § 201(d)(2) as such, they consist of the rights of reproduction, adaptation, distribution, public display and performance 17 U.S.C. § 106. These are the only exclusive rights that can be divided, transferred, and "owned" separately, and it is their ownership that confers the protections and remedies accorded to a copyright owner under the 1976 Act.[5]

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[5] A "transfer of copyright ownership" is defined in the Act as:

> an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

17 U.S.C. § 101. Put another way, the assignment of something other than an exclusive right in the copyright (*e.g.*, a nonexclusive license) is not an assignment of an "ownership" interest under the 1976 Act, and the Act expressly says as much. *See, e.g., Latin Am. Music Co. v. Archdiocese of San Juan*, 194 F. Supp. 2d 30, 49 (D.P.R. 2001), noting that nonexclusive licensees to not have standing to bring infringement suits under § 501(b). *See also R. Ready Productions*, 85 F. Supp. 2d at 684 n.11; *Broadcast Music*, 1983 WL 1136, at *5-*7; 3 NIMMER § 12.02[B], at 12-56 & n.9.

A "cause of action" or "claim for infringement" is not among the statutorily defined divisible rights in § 106; it instead is one of the *remedies* afforded to the owners of § 106 rights by § 501(b) of the Act. *See R&R Recreation Prods., Inc. v. Joan Cook Inc.*, No. 91-Civ.-2589 (JSM), 1992 WL 88171, at *4 (S.D.N.Y. Apr. 14, 1992).

Since only the owner of an exclusive right in a copyright is considered an "owner" of the copyright and is afforded "the protection and remedies accorded to [the] copyright owner[s]" under the statutory provisions cited above, § 501(b) states that

> *the legal or beneficial owner of an exclusive right* under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it.

17 U.S.C. § 501(b) (emphasis added). Thus—on the basis of the plain and unambiguous language of the statute—in order to have standing to enforce a right in copyright for infringement, the claimant must be a legal or beneficial owner of the particular exclusive right alleged to have been infringed. The Decision so held. (App.7-8, 17-18.)

This result is in harmony with other relevant intellectual property law. This Court and lower federal courts consistently have held that an assignee of a bare cause of action for patent infringement has no standing to sue for infringement. *E.g., Crown Die & Tool Co. v. Nye Tool & Mach. Works*, 261 U.S. 24, 39 (1923); *Prima Tek II, L.L.C. v. A-Roo Co.*, 222 F.3d 1372, 1381 (Fed. Cir. 2000); *A. L. Smith Iron Co. v. Dickson*, 141 F.2d 3, 6 (2d Cir. 1944) (L. Hand, J.). *See also Int'l Soc'y for Krishna Consciousness*

v. *Stadium Auth.*, 479 F Supp. 792, 797 (W.D. Pa. 1979) (holding that the assignee of a bare chose in action to sue for trademark infringement has no standing to maintain such a suit under the Lanham Act).

In enacting the 1976 Act, moreover, Congress recognized that the change from a regime under which a single "proprietor" had standing to sue to one in which every owner of an exclusive right had standing could lead to a "multiplicity" of litigation. Congress specifically focused on § 501(b) as *limiting* who could sue:

> The principle of the divisibility of copyright ownership, established by section 201(d), carries with it the need in infringement actions to safeguard the rights of all copyright owners and *to avoid a multiplicity of suits*. Subsection (b) of section 501 enables *the owner of a particular right* to bring an infringement action in that owner's name alone, while at the same time ensuring to the extent possible that the other owners whose rights may be affected are notified and given a chance to join the action.

H.R. REP. NO. 94-1476, at 158-59 (1976) (emphasis added), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774-75. Thus, that § 501(b) denies standing to a plaintiff such as Silvers was specifically contemplated by Congress.

Moreover, as the Decision recognized (App. 6-7), the provisions in the 1976 Act concerning recordation further evidence that Congress did not intend to allow suits by assignees of bare claims (as well as illustrate one of the serious practical problems that would result from the rule Silvers urges). Congress provided a mechanism for the

recordation of transfers of copyright interests, and for determining the priority of recorded interests, which in turn assists defendants (or potential defendants) in determining whether an adverse party is truly the entity with which the defendant should be litigating, or attempting to resolve, a dispute. *See* 17 U.S.C. § 205. In contrast, the Act does not provide for the recordation of assignments of causes of action for copyright infringement, nor for resolution of conflicting claims to the ownership of such causes of action. Thus, to take but a single example, a potential defendant facing an assigned claim and wishing to settle in advance of litigation would have no way of using the recordation system to assure that he was dealing with the true owner of the claim. Congress, no doubt, provided for the recordation of transfers of copyright ownership but not for transfers of copyright claims because Congress never contemplated that assignees of such naked claims would have standing to sue.

In making her arguments, Silvers rides roughshod over another key facet of the 1976 Act: the "work made for hire" doctrine. Although Silvers indisputably wrote the script for "The Other Woman" as a work for hire, Silvers intimates that she has some special relationship to that work as its "creative force" (Pet. at 6) and goes so far as to mischaracterize herself as "the original author" (Pet. at 3).[6]

[6] Silvers relies on the dissenting opinion of Judge Berzon for this proposition. That opinion takes the position that Silvers is the "original creator" of the work in suit, and has a "significant interest in the infringement" as such. (App.25.) This is entirely at odds with settled work-for-hire principles and the interests of those industries, including the motion picture industry, which necessarily rely upon a predictable mechanism for securing both ownership and authorship rights *ab initio*. *See generally* 5 NIMMER at § 23.06[A], at 23-214 to -215.

(*footnote continued on the following page*)

However, the work-made-for-hire doctrine, as codified in the 1976 Act, makes it plain that Silvers is not the author of the work, and has no rights in it. *See* 17 U.S.C. §201(b) ("In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for the purposes of this title . . . and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all the right comprised in the copyright.") Thus, she is not the author of the work for any purpose, including standing to assert a claim for alleged infringement. *Moran v. London Records, Ltd.* 827 F.2d 180, 182-83 (7th Cir. 1987). The writer's interest in a work for hire is, as a matter of law, that of a stranger to the work.

2. The Alleged Inconsistencies In The Decision Are Nonexistent

Silvers also offers a parade of alleged inconsistencies in reasoning and anomalies that supposedly flow from the Decision. In quarreling with the implications she believes the Decision has for other potentially imaginable cases, Silvers argues issues not presented on the record here. First, Silvers says that the Decision prohibits *all* assignments of copyright claims (*see, e.g.*, Pet. at 3 ("This petition seeks review of a decision holding that Section 501(b) of the 1976 Act prohibits the assignment of an accrued cause of action for copyright infringement . . . "), 5-6

It is worth noting that Congress explicitly considered and rejected a proposed provision in the 1976 Act, advanced by screenwriters and composers for motion pictures, that would have granted them "rights" in their contributions to films similar to that claimed by Silvers here. *See* H.R. REP. No. 94-1476, at 121 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5736-37.

("Logically, the majority's construction of Section 501(b) would preclude all assignments of copyright infringement claims . . including those accompanying assignment of the copyright.")). The Decision, however, is expressly to the contrary: Referring to the Second Circuit's decision in *ABKCO* that a plaintiff who purchased both a copyright and accrued claims for its infringement did have standing to sue, the Decision states that "[t]his holding makes perfect sense." (App.17 n.1.) Thus, rather than prohibiting the assignment of claims, the decision states its agreement with decisions allowing assignment of claims together with assignment of copyright ownership.[7]

Silvers also argues (*see* Pet. at 12-13) that the Decision "creates confusion" about whether an infringement cause of action could be assigned to a party that has an entirely unrelated exclusive right in the copyright. In other words, for example, if the owner of a copyright in a play transfers the exclusive right to perform it in New York together with an accrued claim for infringement by virtue of an unauthorized performance in Los Angeles, would the transferee have standing to sue on the Los Angeles claim? The answer, "no," is clear beyond argument in the plain text of the Act, which requires a coincidence of the rights owned and the rights sued upon for a plaintiff to have standing. *See* 17 U.S.C. §§ 201(d)(2), 501(b). Nothing in the Decision contradicts that plain statutory meaning

[7] Silvers again evidences her misapprehension of the Decision in her articulation of the questions presented in the instant petition—namely, her inaccurate claim that her petition would require this Court to determine "Whether Section 501(b) of the 1976 Copyright Act *prohibits the assignment of an accrued cause of action* for copyright infringement . . . ." (Pet. at i (emphasis added))

Lastly, Silvers suggests a transaction as an artful way of satisfying the statutory ownership criteria (Pet. at 13-14). a plaintiff acquires both the copyright and an accrued cause of action for infringement from the copyright owner, only to promptly assign back the copyright, thus leaving the plaintiff with a bare cause of action. Silvers argues that this plaintiff would have standing and it is therefore "absurd" to deny standing here The courts, however, regularly scrutinize transactions to determine whether they are bona fide, and are well-equipped to do so Silvers's hypothetical transaction hardly seems to involve a true transfer of the copyright. In all events this case does not present that question

C. Silvers's Lack Of Standing Cannot Be Cured By Joining Her Assignor

Silvers advances the additional argument that the Decision errs in not providing for the joinder of the copyright owner to cure her lack of standing. (Pet at 15-16.) But as the district court found. Silvers "signed an agreement forbidding her from joining her assignor " (Opp Add 3) Joinder is thus not available as a remedy for Silvers's lack of standing

Nor is there any logic to the idea that joinder can cure Silvers's lack of standing. Frank & Bob's presence in the suit would not in any way change the fact that Silvers herself simply lacks standing to assert the claim. Certainly none of the cases Silvers cites holds (or even suggests) that a stranger to the ownership of the copyright can bring an infringement claim if she joins the copyright owner. For example, in *Independent Wireless Telegraph Co. v. Radio Corp. of Am.*, 269 U S 459, 461 (1926), cited by Silvers,

the plaintiff who was permitted to proceed in a patent case had an exclusive license.

Further, as shown above, Congress has determined that only owners of exclusive rights can be copyright infringement plaintiffs. Silvers asks this Court to overrule Congress and permit someone who is not such an owner to be a plaintiff because, Silvers believes, courts can use joinder to avoid the problems that inhere in suits by non-owners. Silvers may believe that Congress erred in not providing for standing to bare assignees, but she disregards that the task at hand is to apply the Copyright Act, not to rewrite it.

Finally, Congress has implicitly rejected Silvers's "joinder" argument Section 501(b) explicitly allows a court to "require the joinder, [or] permit the intervention, of any person having or claiming an interest in the copyright" at issue in a lawsuit. 17 U.S.C § 501(b). Joinder, therefore, is a mechanism to allow a third party, whose ownership interest in a portion of the copyright could be affected by a lawsuit, to intervene and be heard. By explicitly acknowledging in § 501(b) the existence and utility of joinder in certain situations—namely, where one owner of an exclusive interest brings an infringement suit that might affect the rights of other owners—Congress showed that it considered the issue of joinder when specifying who had standing, and did not authorize joinder to cure a lack of standing on the part of a plaintiff who is a legal stranger to the copyright.

CONCLUSION

The proposition that the 1976 Act does not afford standing to those who have never held an ownership interest in the underlying copyright is supported by the plain language of the Act, by its legislative history, by established precedent in the Second Circuit, and by established precedent in analogous areas of intellectual property law As clearly shown both above and in the Decision, *Prather v. Neva Paperbacks*—a case decided more than 35 years ago, under a different statute, and which is factually distinguishable from the instant case—is not in conflict with the Decision Accordingly, Silvers's petition for writ of certiorari should be denied

Respectfully submitted,

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Add. 1

Order Granting Defendants' Motion for Interlocutory Appeal

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

No. CV-00-6386 SVW (RCx)
Filed: March 29, 2001

NANCY SILVERS,

Plaintiff,

v.

SONY PICTURES ENTERTAINMENT, INC., et al.,

Defendants.

ORDER GRANTING DEFENDANTS' MOTION FOR INTERLOCUTORY APPEAL

I Introduction

The essence of Plaintiff's complaint is that Defendants' motion picture "Stepmom" infringed the copyright of the television movie "The Other Woman," which Plaintiff wrote on a work-for-hire basis for the production company Frank & Bob Films II.

In a prior motion to dismiss, Defendants argued that Plaintiff lacks standing to sue because she is not the registered owner of the copyright. Plaintiff responded that she does have standing to sue because the registered owner of

the copyright. Frank & Bob, assigned to her the accrued cause of action for infringement In our January 26, 2001 Order, the Court agreed with Plaintiff holding that an assignee of an accrued cause of action has standing to sue without the need to join her assignor, even if the latter retains ownership of all other rights under the copyright The Defendants have moved for certification of our Order of January 26, 2001 for interlocutory appeal under 28 U.S.C. § 1292(b).

II Discussion

Section 1292(b) allows this Court to certify for immediate appeal a non-final order where "such order involves a controlling question of law as to which there is substantial ground for difference of opinion and [ ] an immediate appeal . . may materially advance the ultimate termination of the litigation " 28 U.S.C § 1292(b)

a Controlling Question of Law

The "controlling question of law" involved in the Court's Order is whether Plaintiff has standing to bring her lawsuit. The basis for federal jurisdiction over the case is Plaintiff's copyright infringement cause of action. If Plaintiff lacks standing to sue, then her case will be dismissed This standing question meets the Ninth Circuit's definition of a "controlling question of law" See *United States v. Woodbury*, 263 F 2d 784, 787 (9th Cir. 1959) (holding that a "controlling question of law" is one "which, if decided in favor of the appellant, would end the lawsuit "), *Forest Guardians v. Bureau of Land Mgmt.*, 188 F.R.D 389, 396 (D N M. 1999) ("(s)tanding is a controlling question of law, so it meets the first requirement of § 1292(b) ")

b. Substantial Ground For Difference of Opinion

The Court's January 26, 2001 Order explained in some detail that it is not a settled question of law whether an assignee of an accrued cause of action has standing to sue without the need to join her assignor, when the latter retains ownership of all other rights under the copyright Plaintiff argues that the Court, although reaching the right conclusion, incorrectly interpreted the case law so as to see conflict where there is none. The Court has fully addressed Plaintiff's arguments in our prior Order. The Court believes its prior Order demonstrates that a substantial ground for difference of opinion exists.

c. Materially Advancing The Termination of Litigation

A determination of standing will materially advance the termination of litigation. Plaintiff argues she can cure any standing problem by joining her assignor of the accrued cause of action as a party. However, Plaintiff, in consideration of the assignment of the accrued cause of action, signed an agreement forbidding her from joining her assignor.

Therefore, the determination of Plaintiff's standing will determine whether this case will continue or be dismissed.

III. Conclusion

This Court's January 26, 2001 Order meets the statutory requirements for certification under 28 U.S.C. § 1292(b). This proceeding is stayed pending an order from the Ninth Circuit granting or denying Defendants' appeal.

IT IS SO ORDERED.

DATED: 3/28/2001

/s/ STEPHEN V. WILSON
STEPHEN V WILSON
UNITED STATES DISTRICT JUDGE

Add. 5

Assignment of Claims and Causes of Action

1. Assignment of Cause of Action For valuable consideration, the receipt and sufficiency of which is hereby acknowledged, Von Zerneck/Sertner Films and Frank and Bob Films II (collectively, "Assignors"), hereby sell, transfer, and assign to Nancey Silvers ("Assignee") all right, title and interest in and to any claims and causes of action against Sony Pictures Entertainment, Inc., Columbia TriStar, and any other appropriate persons or entities, with respect to the screenplay *The Other Woman* (also and previously known as *Mothers and Daughters* and *A Journey of Love*) and all other drafts thereof, on the one hand, and the motion picture *Stepmom*, on the other

2. Authority Granted by Assignment. This assignment is intended to convey to Assignee all of Assignors' rights, titles and interests in the assigned claims and causes of action. Additionally, Assignee acquires the full power to prosecute, compromise, settle, reassign, and give a release in full settlement of the claims and causes of action.

3 Effect on Heirs and Successors. This assignment and each of its provisions shall be binding on and shall inure to the benefit of the respective heirs, devisees, legatees, executors, administrators, trustees, successors, and assigns or the parties to this assignment

4. Amendments to Assignment. This assignment may be amended only by a writing signed by the party against whom or against whose successors and assigns enforcement of the change is sought.

5 Indemnity. Assignee shall indemnify, protect, defend and hold harmless Assignors from and against any and all claims, damages, costs, judgments, attorneys' fees, expenses and/or liabilities arising out of, involving, or in connection with, this assignment In case any action is brought against Assignors by reason of this assignment, Assignee upon notice by Assignors shall defend the same at Assignee's sole cost and expense by counsel reasonably satisfactory to Assignors and Assignors shall cooperate with Assignee in such defenses, as and when reasonably requested

6 No Publicity. Assignee shall not use, caused to be used, or consent to the use or mention of Assignors' respective names or the names of any and all principals, employees, agents, attorneys, subsidiaries and affiliated companies of Assignors in connection with any publicity regarding the claims and/or causes of action described herein without the prior written consent of Assignors.

///
///
///

7 Notices. Any notices required to be given pursuant to this assignment shall be given by first class mail as follows

To Assignors

Von Zerneck/Sertner Films
Frank & Bob Films II
12001 Ventura Place
Suite 400
Studio City, California 91604

with a copy to:

Hansen, Jacobson, Teller, Hoberman,
Newman & Warren
Hertz & Goldring
450 North Roxbury Drive
Ninth Floor
Beverly Hills, California 90210-4222
Attn: Thomas Hoberman, Esq.

To Assignee:

Ms. Nancey Silvers
142 North Stanley
Beverly Hills, California 90212

with a copy to:

Liner Yankelevitz Sunshine Weinhart
& Regenstreif, LLP
3130 Wilshire Boulevard
Second Floor
Santa Monica, California 90403
Attn: Joseph R. Taylor, Esq.

8. Effect of Partial Invalidity. If any term or provision of this assignment or any application thereof shall be held invalid or unenforceable, the remainder of this assignment and any application of the terms and provisions shall not be affected thereby, but shall remain valid and enforceable.

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///

9 Governing Law. This assignment shall be governed by and construed in accordance with the laws of California

ASSIGNORS

VON ZERNECK/SERTNER FILMS

By: /s/ [illegible]
Its: Partner

By: /s/ [illegible]
Its: Partner

FRANK & BOB FILMS II

By /s/ [illegible]
Its: Partner

By. /s/ [illegible]
Its: Partner